

*Connelly*

communication terminal, recognizes the user according to the bar code, performs the processing to provide the service, and sends information about a new service generated in relation to the service to the server, so that the server registers the received information about the new service in the second personal database in order to cause the information about the new service to be reflected in the service content to be delivered by the second delivery means at the time of the next delivery.

#### REMARKS

By the present amendment, Applicants have cancelled claims 1-25, without prejudice or disclaimer of the subject matter thereof, amended claims 26-28 to more appropriately define the invention, and added new claims 29-41 to protect additional aspects of their invention.

As discussed on pages 2-6 of the last Office Action, the Examiner rejected claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,373,440 (hereinafter "Cohen et al.") in view of U.S. Patent No. 5,534,857 (hereinafter "Laing et al."). Furthermore, the Examiner rejected claims 1-25 and 28 under 35 U.S.C. § 102(b) as being anticipated by Cohen et al.

#### 35 U.S.C. § 103(a)

The Examiner rejected claims 26 and 27 under § 103(a) as unpatentable over Cohen et al. in view of Laing et al. This rejection is respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, each of three requirements must be met. First, the references when combined must teach or suggest each and every

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element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. (See *id.*) Third, a reasonable expectation of success must exist. (See *id.*) Moreover, each of the these requirements must “be found in the prior art, and not based on Applicants’ disclosure.” See M.P.E.P. § 2143 (8th ed. 2001).

Cohen et al. and Laing et al. combined do not disclose each and every element of claim 26, including at least, “means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain service content that suits the user's tastes.” (Claim 26, emphasis added). The Examiner admits that “Cohen et al. fails to disclose means to create/generate enciphering codes or bar codes.” See Office Action, p. 5. Furthermore, Laing et al. simply discloses “a method and apparatus for securely writing confidential data from an issuer to a customer smart card at a remote location.” (Laing et al., Abstract and col. 6, line 45 through col. 7, line 13) However, Laing et al. does not disclose at least, “means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in [a] personal database and by specifying certain service content that suits the user's tastes” (claim 26, emphasis added).

In addition, there is no suggestion or motivation, either in Cohen et al., Laing et al., or the knowledge generally available to one of ordinary skill in the art to combine the references in a manner resulting in the claimed invention. The Examiner simply

concludes, “[i]n view of the teaching of Laing et al., it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the enciphering code design into the teaching of Cohen et al. in order to protect and secure the genuineness, personal and secret information of the user/patron.” Office Action, p. 5. Yet, the Examiner gives no support from either Cohen et al., Laing et al., or the knowledge available to one of ordinary skill in the art that the enciphering techniques of Laing et al. would be useful in the Cohen et al. invention. In fact, those practicing Cohen et al. would not be inclined to use the techniques of Laing et al. since repeated use of the games cards in Cohen et al. is not desirable. Since continuous transfer of information onto the card is not a design goal, protection of confidential user information in the manner disclosed by Laing et al. is unnecessary. Therefore, it would not have been obvious to one of ordinary skill in the art to combine the two references. Furthermore, such motivation or suggestion to combine these references does not exist, unless the applicant’s disclosure is relied upon, which is improper use of hindsight knowledge. (See M.P.E.P § 2143).

Thus, without any detailed citations to a reference or other extrinsic evidence, the Examiner is relying on a conclusory statement that a person of ordinary skill in the art would use the enciphering code design of Laing et al. into the teaching of Cohen et al.. However, nothing in Laing et al. suggests combining its teaching with Cohen et al., or vice versa. The Examiner has not provided a source of such motivation to combine those references. Insofar as the Examiner may be relying on Official Notice, the law is clear as to “Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art.” If an applicant traverses (and Applicants do hereby so traverse) a rejection based on facts

taken as Official Notice by the Examiner, "the Examiner should cite a reference in support of his or her position." Furthermore, "when a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner." (See M.P.E.P. § 2144.03). Accordingly, Applicants request that the Examiner cite a competent reference, or furnish an affidavit to support the facts for which Official Notice has been taken, or else withdraw these grounds of rejection.

Moreover, there is no indication of a reasonable expectation of success by combining the techniques of Cohen et al. with Laing et al. The references have different design goals and considerations. Cohen et al. seeks to protect the producer of the game card by preventing a game player from repeatedly using the same game card. If a game player is allowed to continuously transfer information onto one card, the game cards are no longer temporary in nature. Laing et al., on the other hand, seeks to protect the customer or card holder by allowing for secure transfer of confidential information onto a smart card without third party access to the smart card. In Cohen et al., certain third parties do want access to the information on the card in order to control operation of the game machine and to prevent repeated use of the game machine by a game card.

Accordingly, claim 26 is allowable under 35 U.S.C. § 103(a) and Applicants respectfully request the Examiner to withdraw the rejection to claim 26. Furthermore, claims 27 and 28, each dependent upon claim 26, recite additional limitations that are neither disclosed nor suggested by any of the cited references, taken alone or in

combination. Further, claims 28-31 are dependent upon claim 27 and recite additional limitations that are neither disclosed nor suggested by any of the cited references, taken alone or in combination. Thus, claims 27-31 are allowable for at least the same reasons discussed above with respect to independent claim 26.

Claims 32 and 37 are also allowable for similar reasons as claim 26. Specifically, the limitations of claims 32 and 37 are neither disclosed nor suggested by any of the cited references, taken alone or in combination, including at least, "means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain service content that suits the user's tastes" (claims 32 and 37, emphasis added). Additionally, claims 33-36 and 38, each dependent upon one of claims 32 and 37, recite additional features that are neither disclosed nor suggested by any of the cited references, taken alone or in combination. Moreover, as discussed earlier with regard to claim 26, there is no motivation to combine Cohen et al. and Laing et al. Thus, claims 32-38 are allowable for at least the reasons discussed above and with the discussion of the allowability of claim 26.

Claims 39-41 are also allowable. Specifically, the features of claims 39-41 are neither disclosed nor suggested by any of the cited references, taken alone or in combination. Moreover, as discussed earlier with regard to claim 26, there is no motivation to combine Cohen et al. and Laing et al. Thus, claims 39-41 should be allowed.

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**35 U.S.C. § 102(b)**

The Examiner rejected claims 1-25 and 28 under 35 U.S.C. § 102(b) as being anticipated by Cohen et al. While Applicants disagree with the basis of rejection of claims 1-25, Applicants have, without prejudice or disclaimer of the subject matter thereof, cancelled claims 1-25 solely in an effort to expedite the prosecution of the present application. Thus, the rejection of those claims is rendered moot.

The rejection of claim 28 is respectfully traversed for the following reasons. In order to properly anticipate claim 28 under § 102(b), Cohen et al., taken individually, must explicitly disclose each and every limitation recited in the claims. See M.P.E.P § 2131 (8<sup>th</sup> ed. 2001).

Claim 28 is dependent upon claim 26 or claim 27 and thus includes all the recitations of either of those claims. Cohen et al. does not disclose each and every element recited in claim 28, including at least, "means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain service content that suits the user's tastes." See e.g., claim 26. In the last Office Action, the Examiner conceded that "Cohen et al. fails to disclose means to create/generate enciphering codes or bar codes." See Office Action, p. 5. Accordingly, claim 28 is allowable over Cohen et al. under § 102(b) and Applicants respectfully request the Examiner to withdraw the rejection to claim 28.

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**APPENDIX TO AMENDMENT OF MARCH 5, 2003**

**Version with Markings to Show Changes Made**

Amendments to the Claims:

26. (Twice Amended) A service providing system for providing a specified service by registering a user's personal information [of a user] at a server by utilizing a communication terminal,

wherein the server comprises:

a personal database for registering the user's personal information sent from the communication terminal;

means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain [a given] service content [from] that suits the user's [personal information,] tastes; and

means for delivering image data, including the bar code, to the user's[,] communication terminal, wherein the communication terminal comprises a storage means for storing the delivered image data and a displaying means for displaying the image data, and

wherein [at a service providing facility where] an information processing terminal having a bar code reader [is provided] reads, using its bar code reader, [the user causes the information processing terminal by means of] the bar code [reader to read the bar code] contained in the image data displayed on the display means of the

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communication terminal, [and the information processing terminal] recognizes the specified user and service content according to the bar code, [performs the] executes the necessary processing to provide a service according to the service content, and sends new personal information generated by the service to the server[, and updates] so that the new personal information [of the user so that] is reflected in the service content for the next delivery.

27. (Twice Amended) The service providing system according to claim 26, wherein the server has a product information database for registering specified information [registered therein] according to a plurality of products,

wherein the means for creating the bar code creates an enciphered bar code to specify the user according to the user's personal information,

wherein [at the service providing facility comprising a plurality of products, each having a] the information processing terminal specifies the user by reading, using its bar code reader, the bar code displayed on the display means of the communication terminal, and specifies a product selected by the user among the plurality of products with their respective bar codes displayed thereon, [the user causes the bar code reader to read the bar code displayed] by reading, using its bar code reader, the bar code [on] of [a] the product selected [among the products] by the user, and sends the bar code of the selected product [bar code to the server] as information regarding a purchased product of the user,

[wherein on the basis of the received selected product bar code, the server identifies the selected product among the registered products, creates a new bar code

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enciphering a specified service content regarding this product, and sends image data containing the new bar code to the user.]

wherein the server registers, in the personal database, the received information about the user's purchased product and presumes the user's tastes according to a purchase history of the user so that said presumption of the user's tastes is reflected in the service content for the next delivery, and

wherein the purchase history is registered in the personal database and comprises a list of purchased products registered in the personal database.

28. (Twice Amended) A machine readable storage medium having a program stored therein for causing a computer to download data in the service [ticket issuing] providing system according to claim [1] 26 or claim [2] 27.

29. (New) The service providing system according to claim 27, wherein the server specifies the service content for the next delivery on the basis of the user's purchase history in the personal database, so that a better service rate will be provided with regard to products having a high purchase frequency.

30. (New) The service providing system according to claim 27, wherein the server specifies the service content for next delivery on the basis of the information, which is registered in the product information database, regarding products for which a seller wants to increase sales, and on the basis of the user's purchase history in the personal database.

31. (New) The service providing system according to claim 27, wherein when the received bar code of the product purchased by the user corresponds to an identification of a previously determined discount product, the server notifies the

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information processing terminal of a service to allow application of the discount to the price of the product purchased by the user.

32. (New) A server for sending a bar code representing a specified service content to a communication terminal,

wherein the server comprises:

a personal database for registering a user's personal information sent from the communication terminal;

means for creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain service content that suits the user's tastes; and

means for delivering image data, including the bar code, to the communication terminal, and

wherein when an information processing terminal having a bar code reader reads, using its bar code reader, the bar code contained in the image data displayed on the display means of the communication terminal, recognizes, according to the bar code, the user and the service content that suits the user's tastes, performs the processing to provide a service according to the service content that suits the user's tastes, and sends new personal information generated by the service to the server, the server updates the user's personal database on the basis of the received new personal information of the user and specifies the service content for next delivery according to the updated new personal information of the user.

33. (New) The server according to claim 32, comprising a product information database for registering specified information according to a plurality of products, and

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means for creating an enciphered bar code to specify the user according to the user's personal information,

wherein when the information processing terminal specifies the user according to the bar code displayed on the display means, and specifies a product selected by the user among the plurality of products with their respective bar codes displayed thereon, by reading, with its bar code reader, the bar code of the product selected by the user, and sends the information about the product purchased by the specified user to the server, the server registers the received information about the user's purchased product in the personal database, and presumes the user's tastes according to the user's purchase history so that such presumption of the user's tastes is reflected in the service content to be delivered next time.

34. (New) The server according to claim 33, wherein the server specifies the service content for next delivery on the basis of the user's purchase history registered in the personal database so that a service rate with regard to products of high purchase frequency will be increased.

35. (New) The server according to claim 33, wherein the server specifies the service content for next delivery on the basis of the information, which is registered in the product information database, about products for which a seller wants to increase the sales, and on the basis of the user's purchase history registered in the personal database.

36. (New) The server according to claim 33, wherein when the received bar code of the product purchased by the user corresponds to an identification of a previously determined discount product, the server notifies the information processing

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terminal of the service to allow the discount on the price of the product purchased by the user.

37. (New) A service providing method for providing a specified service by registering personal information of a user at a server by utilizing a communication terminal,

wherein the server comprises the steps of:

registering the user's personal information sent from the communication terminal in a personal database;

creating an enciphered bar code by presuming the user's tastes according to the user's personal information registered in the personal database and by specifying certain service content that suits the user's tastes; and

delivering image data, including the bar code, to the communication terminal,

wherein delivering comprises storing the delivered image data and displaying the image data, and

wherein an information processing terminal having a bar code reader reads, with its bar code reader, the bar code contained in the image data displayed on the display means of the communication terminal, recognizes, according to the bar code, the user and the service content that suits the user's tastes, performs the processing to provide a service according to the service content that suits the user's tastes, and sends new personal information generated by the service to the server so that the new personal information is reflected in the service content for next delivery.

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38. (New) The service providing method according to claim 37, wherein the method comprises the step of registering specified information according to a plurality of products in a product information database, and the step of creating an enciphered bar code to specify the user according to the user's personal information,

wherein the information processing terminal specifies the user by reading, with its bar code reader, the bar code displayed on the display means, and specifies a product selected by the user among the plural products with their respective bar codes displayed thereon, by reading, with its bar code reader, the bar code of the product selected by the user, and sends information about the product purchased by the specified user to the server, and

wherein the server registers the received information about the user's purchased product, and presumes the user's tastes according to the user's purchase history so that such presumption of the user's tastes is reflected in the service content for next delivery.

39. (New) A service providing system for providing a specified service by registering personal information of a user at a server by utilizing a communication terminal,

wherein the server comprises:

a personal database for registering the user's personal information sent from the communication terminal;

means for creating an enciphered bar code by specifying certain service content according to the user's personal information registered in the personal database; and

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means for delivering image data, including the bar code, to the user's communication terminal,  
wherein the communication terminal comprises storage means for storing the delivered image data and display means for displaying the image data, and  
wherein an information processing terminal having a bar code reader reads, with its bar code reader, the bar code contained in the image data displayed on the display means of the communication terminal, recognizes the specified user and service content according to the bar code, and performs processing to provide a service according to the service content.

40. (New) A service providing system capable of conducting communications between a communication terminal and a server through a communication line,  
wherein the server comprises means for creating an enciphered bar code by specifying certain service content and means for delivering image data, including the bar code, to the communication terminal, and  
wherein the communication terminal comprises:  
means for receiving the delivered image data;  
means for storing the received image data; and  
means for displaying the image data, and  
wherein an information processing terminal having a bar code reader reads, with its bar code reader, the bar code contained in the image data displayed on the display means of the communication terminal, recognizes the user and service content according to the bar code, and performs processing to provide a service according to the service content.

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41. (New) A service providing system for providing a specified service at an information processing terminal connected with a server via a network by registering personal information of a user at the server by utilizing a communication terminal,

wherein the server comprises:

a first personal database for registering the user's personal information sent from the communication terminal;

a second personal database for registering information about a service utilized by the user, which information is sent from the information processing terminal;

means for creating an enciphered bar code according to the user's personal information registered in the first personal database;

a first delivery means for delivering image data including the bar code to the user's communication terminal; and

a second delivery means for delivering a specified service content to the user's communication terminal,

wherein the communication terminal comprises means for storing the delivered image data and means for displaying the image data, and

wherein the information processing terminal having a bar code reader reads the bar code contained in the image data displayed on the display means of the communication terminal, recognizes the user according to the bar code, performs the processing to provide the service, and sends information about a new service generated in relation to the service to the server, so that the server registers the received information about the new service in the second personal database in order to cause

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the information about the new service to be reflected in the service content to be  
delivered by the second delivery means at the time of the next delivery.

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**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
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Dated: February 21, 2003

By: *Richard V. Burgujian* Reg 24,014  
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